

### **REMARKS**

Please reconsider the application in view of the above amendments and the following remarks.

#### **Status of Claims**

Claims 1-17 and 19-32 are pending in this application with claims 9-11, 15-19, 23-25 and 30 having been previously withdrawn as the result of a restriction requirement and claims 21 and 22 having been cancelled. Claim 32 is new.

Claims 1-8, 12-14, 20, 26-29 and 31 have been rejected.

### **ARGUMENTS**

Claims 1-6, 12-14, stand rejected under 35 USC § 102(a) as being anticipated by Allen USPN 3070808.

The test for anticipation under 35 USC § 102 is set forth in MPEP §2131, where it is stated that: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). As amended, claim 1 is not anticipated by Allen or any other reference under this standard. The Allen device does not have any "elongations" toward its medial or posterior sides. The four mounds in Allen are symmetrical and are toward the anterior (front) side of the orbit. The mounds mate with the implant at the front of the patient's orbit as shown in Allen's FIG. 7.

In contrast, Applicant's claimed device comprises "an elongation of the implant toward the medial side of the posterior side." This is shown in Applicant's FIGS. 2 and

15 which illustrate that the posterior portion of the implant is not symmetrical as is Allen's semi-spherical device. Instead, Applicants claimed invention is elongated toward one side. The quasi-spherical (asymmetrical) shape of Applicant's claimed invention provides significant advantages over all existing technology of which Applicant is aware because it more naturally aligns with the patient's orbit which helps to prevent the implant from becoming slanted in the socket. In addition, Applicant has inserted language into claim 1 which limits the device to one conical elongation further distinguishing over Allen.

Again, Applicant states with respect to claim 2, Allen's FIGS. 3, 4, and 7 show that Allen does not disclose an off center elongation with respect to the anterior side. With respect to claim 3, Allen's FIGS. 3, 4, and 7 show that Allen does not disclose an astigmatism "defined by the medial and temporal sides being more anterior and the superior and inferior sides being more posterior." With respect to claim 4, Allen's FIGS. 3, 4, and 7 show that Allen does not disclose an astigmatism "defined by a radius which is longer toward the medial and temporal sides of the implant, and which is shorter toward the superior and inferior sides of the implant." Furthermore, claims 2-6 and 12-14 depend on claim 1 in some fashion and are allowable for the same reasons as its independent claim as well as for the further limitations contained therein.

Claims 20, 26, 27, and 29 stand rejected under 35 USC § 102(a) as being anticipated by Finger USPN 6,419,698. Applicant has amended claim 20 to include limitations which Finger does not teach. Additionally, Finger does disclose an orbital implant comprised of several different sections, it does not disclose that the implant is divided between an "anterior portion" and a "posterior portion." The Finger device must

have membrane 20 on the anterior portion as a needle is inserted into the membrane after the device is inserted into a patient. If this were not the case, it would be impossible to insert a needle into the membrane after inserting the device into a patient. Furthermore, claims 26, 27, 29 depend on claim 20 in some fashion and are allowable for the same reasons as its independent claim as well as for the further limitations contained therein.

Claims 20-22, and 26 stand rejected under 35 USC § 102(a) as being anticipated by Hicks USPN 6,346,121. Again, Applicant has amended claim 20 to include the limitations of claims 21 and 22. Additionally, Hicks does not contain tunnels for receiving sutures. The Hicks device teaches a biocompatible hydrophilic polymer which can be directly sutured but does not disclose actual tunnels through which a suture can be pulled through. Therefore, amended claim 20 and dependent claim 29 should be allowed.

Claims 7-18, 18, 20-22, 26-29 and 31 stand rejected under 35 USC § 103(a) as being patentable over Allen 3,070,808 and in further view of Kelman USPN 4,370,760 and/or Hicks USPN 6,346,121 and Rubin USPN 5,466,258. The rejection is respectfully traversed. Applicant, as detailed above, has amended claim 1 to include limitations which none of the cited references contain. As such dependent claims 7 and 8 are allowable for the same reasons as their independent claim as well as for the further limitations contained therein. Although Applicant has cancelled claim 18, it does not concede the rejection argument offered by the Examiner.

Claim 20 has been amended to include limitations not contained in any of the references cited by the Examiner. Specifically, none of the prior art teaches tunnels

having a diameter sufficient to receive a needle and a suture. Therefore, amended claim 20 should be allowed as well as dependent claims 26-29.

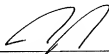
The Examiner has rejected claim 31 under 35 USC § 112. Claim 31 has been amended to remove any subject matter which may not have been fully supported by the specification. Additionally, claim 31 has been amended to include limitations not contained in any of the prior art references. None of the references cited contain an elevated portion which serves as a key for joining an anterior and posterior portion in correct alignment. The Rubin device does not teach two separate parts and thus Fig. 5 of Rubin does not disclose any elements capable of serving as a key, yet alone an elevated portion and corresponding indentation serving as a key.

Any amendments to any claim for reasons other than as expressly recited herein as being for the purpose of distinguishing such claim from known prior art are not being made with an intent to change in any way the literal scope of such claims or the range of equivalents for such claims. They are being made simply to present language that is better in conformance with the form requirements of Title 35 of the United States Code or is simply clearer and easier to understand than the originally presented language. Any amendments to any claim expressly made in order to distinguish such claim from known prior art are being made only with an intent to change the literal scope of such claim in the most minimal way, i.e., to just avoid the prior art in a way that leaves the claim novel and not obvious in view of the cited prior art, and no equivalent of any subject matter remaining in the claim is intended to be surrendered.

In view of the above, it is believed that the application is in condition for allowance and such a Notice is respectfully requested. If anything else is needed to

place the application in condition for allowance, it is kindly requested that the undersigned be contacted.

Respectfully submitted,



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